

Remarks

I. Introduction

This is in response to the Office Action dated August 20, 2008.

Claims 2-5, 12, and 16 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

Claims 6-11, 13-15, and 19-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Patent Cooperation Treaty (PCT) Patent No. WO 97/47119 (Hansson) in view of U.S. Patent Publication No. 2006/0215029 (Katz) and further in view of U.S. Patent No. 6,698,023 (Levitan). Claims 2-5, 12, and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Hansson in view of Katz in view of Levitan in further view of U.S. Patent Publication No. 2007/0168426 (Ludwig).

In response, Applicants have amended claims 2-5 and canceled claims 12 and 16. Claims 1 and 17-18 were previously canceled. Claims 2-11, 13-15 and 19-21 remain for consideration, of which claims 13 and 21 are the only independent claims.

II. Rejections under 35 U.S.C. §112

Claims 2-5, 12, and 16 stand rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In response, Applicants have amended dependent claim 2 to make clear that the downloaded "A/V file is broadcast to the recipient after the recipient authorizes the broadcast." Similar amendments were made to dependent claims 3-5. No new matter was added by these amendments. Support for these amendments may be found in Applicants' Specification at least at page 9, lines 188-201. Additionally, Applicants have canceled dependent claims 12 and 16.

III. Rejections under 35 U.S.C. §103

Claims 6-11, 13-15, and 19-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hansson in view of Katz and further in view of Levitan. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the cited references do not individually show all of the limitations of independent claims 13 and 21 and that the present claims are not obvious in view of these references. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). The cited references do not teach the claim limitations and the Examiner has provided no obvious modification (or rationale for such a modification) of the references that would arrive at the claimed subject matter. In *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007), the United States Supreme Court indicated that it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." No such combination or reason to make the combination is provided in the outstanding rejection.

Independent claim 21, recites "downloading said AV file from said sender to a server associated with the recipient data network address via said data network during said voice connection." Independent claim 13 recites similar features. That is, an audiovisual file (e.g., a HTML document) originally stored at a user's computer is downloaded to a server associated with a recipient. The direction (e.g., pointer) to the server location is given by the "recipient data network address." Hansson and Katz fail to show this claim limitation, as indicated on page 5 of the present Office Action.

The present Office Action points to Levitan to show this limitation, then concludes "it would have been obvious... to have modified Hansson and Katz's invention with downloading the file at a server prior to sending it to the recipient as taught by Levitan for the [sic] providing storage capabilities to the NT unit (Levitan, col. 7-10) in the case the user wants to save the file."

First, Applicants respectfully submit that the cited section of Levitan does not teach this feature. Applicants' independent claim 21 recites "downloading

said A/V file from said sender to a server associated with the recipient data network address via said data network during said voice connection" and "receiving navigation instructions to navigate through said A/V file from said recipient via said voice connection." Independent claim 13 recites similar features. There is an interplay between claim limitations that must be considered and *Applicants' claims must be considered as a whole*. See MPEP §2141.02/

As discussed above, the A/V file is downloaded to a server associated with a specific recipient – the specific recipient is the recipient that has established a voice connection with the sender and sends navigation instructions to the server. In other words, the server is an integral part of Applicants' claims and must have the capability to "receiv[e] navigation instructions to navigate through said A/V file from said recipient via said voice connection."

Levitan does not teach or suggest such a server. As discussed throughout the reference and indicated on page 6 of the present Office Action, the server of Levitan is used to broadcast information to multiple users and does not appear to allow receipt of navigation instructions from those users. Accordingly, it does not show the limitations of Applicants' independent claims 13 and 21.

Second, Applicants respectfully submit that there is no "Hansson and Katz's invention" as stated in the present Office Action. The present Office Action lists pieces of the disclosures of Hansson and Katz and provides conclusory statements that they could be combined to provide a portion of Applicants' claimed invention. The present Office Action does not provide the required reason for the combination, merely providing a conclusory statement that it would have been obvious "to modify Hansson's invention by using telephones that allow control [of] the navigation of the received video as taught by Katz for the benefit of giving the convenience to the user of not using another device..." (Office Action, Page 5, third complete paragraph). This section of the Office Action merely states that it was obvious to combine the references because it would have provided the benefit achieved by the combination. Applicants respectfully submit that this is not an identified *"reason that would*

have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does" (emphasis added) as discussed in *KSR International Co. v. Teleflex Inc.* It is a mere restatement of the results of Applicants' claims.

The combination of these references appears to be based on impermissible hindsight reconstruction. No reasoning has been provided other than a restatement of the teachings of the present invention. While express motivation in the references is not required, a clearly identified reason as to what would have prompted one of skill in the art to modify the references is still required under the authority of *KSR International Co. v. Teleflex Inc.* See, for example, MPEP § 2141 and § 2145. Applicants respectfully submit that stating a benefit of the partial combination of Hansson and Katz does not qualify as an identified reason that would have motivated one of skill in the art to combine the references. Therefore, the Examiner has not made a prima facie case of obviousness.

Third, since the teachings of Hansson and Katz are not an "invention" and are not related except in general subject matter, Applicants respectfully submit that they cannot be used as a single base reference. That is, the present Office Action presents the combined teachings of Hansson and Katz as a starting point for combination with the teaching of Levitan. Absent an explicit reason to combine all three references at once, this is inappropriate.

Put another way, the teachings of Hansson, Katz, and Levitan are independent of each other. One of skill in the art would not have been motivated to look at any one of these references and combine it with one of the other references to arrive at part of Applicants' claims. For example, since the teachings of Levitan are not included in either Hansson or Katz, there is no reason to combine the references in the manner presented in the present Office Action because, without the teachings of Levitan, the A/V files have not been downloaded to a server and it would not make any sense to navigate through the non-existent downloaded files (with the teachings of Katz).

Accordingly, in order to combine Hansson, Katz, and Levitan, the Examiner must provide a reason that would have prompted a person of ordinary skill in the relevant field to combine elements of *all* of the references in the way the Applicants' independent claims 13 and 21 do. Partial combinations building to a complete combination is inappropriate, especially in the case where the partial combination is inoperable (e.g., the combination of Hansson and Katz presented in the present Office Action.)

Applicants respectfully submit that no reasoning has been provided to combine all of the elements of Applicants' claims other than a restatement of the teachings of the present invention. While express motivation in the references is not required, a clearly identified reason as to what would have prompted one of skill in the art to modify the references is still required under the authority of *KSR International Co. v. Teleflex Inc.* See, for example, MPEP § 2141 and § 2145. Applicants respectfully submit that stating a benefit of the partial combination of Hansson and Katz does not qualify as an identified reason that would have motivated one of skill in the art to combine all of the references and the Examiner has identified no reason to combine Levitan, Hansson, and Katz at once. Therefore, the Examiner has not made a *prima facie* case of obviousness.

For at least this reason, Applicants respectfully request the Examiner reconsider and withdraw the §103 rejections of independent claims 13 and 21. Dependent claims 2-11, 14, 15, and 19-20 depend upon an allowable independent claim and are therefore also allowable. Therefore, Applicants respectfully request reconsideration and withdrawal of the §103 rejections of dependent claims 2-11, 14, 15, and 19-20.

IV. Conclusion

For the reasons discussed above, all pending claims are allowable over the cited art. Reconsideration and allowance of all claims is respectfully requested.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Donald E. Marshall', is written over a horizontal line.

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